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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,790	04/16/2004	Edward A. O'Donnell	TKG4360	6668

34356 7590 10/29/2004

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EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,790

Applicant(s)

O'DONNELL, EDWARD A.

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings were received on 5/28/04. These drawings are approved.

Specification

2. The use of the trademark VELCRO has been noted in this application (see abstract and page 5). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claims 1 and 8 are objected to. Claim 1, line 20, "said stern" should be "said stern section". Claim 1, line 27, "said traveler bar" should be "said bar", or the bar should be recited as a "traveler bar". Claim 8 has similar recitations. Consistent terminology should be used. Appropriate correction is required.
4. Claims 2 and 9 are objected to. Claim 2, lines 1-2, "said mast maintaining means" is inconsistent with the original recitation of the element. Consistent terminology should be used. Claim 2, line 3, "hosting" should be "hoisting". Claim 9 has similar recitations. Appropriate correction is required.
5. Claims 3 and 10 are objected to. Claim 3, lines 1-2, "said mast maintaining means" is inconsistent with the original recitation of the element. Consistent terminology should be used. Claim 3 recites "further comprises". Please clarify if claim

Art Unit: 3617

3 depends from claim 1 or from claim 2. For examination it will be assumed to depend from claim 1. Claim 10 has similar recitations. Appropriate correction is required.

6. Claims 7 and 13 are objected to. Claim 7, line 5, "said youloh" is not consistent with the initial recitation "a Chinese youloh". It is suggested to delete the word "Chinese" from the recitation in claim 5. Claim 13 has similar recitations. Consistent terminology should be used. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 5, 7, 11, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 5 recites "a Chinese youloh". This term is used in the specification (abstract, page 3, page 6). The term does not have a recognized meaning in the art. The term is not defined or described in the specification. Therefore the disclosure is non-enabling. Claim 7 depends from claim 5. Claims 11 and 13 have a similar recitation.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3617

10. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 3 and 10 recite the trademark "Velcro". The recitation of a trademark renders the claim indefinite. It is suggested to use generic terminology such as "hook and loop fastener".

12. Claim 1 recites "means for selectively maintaining said mast section at a substantially stable position" in lines 15-16. This recitation invokes 35 USC 112, 6th Paragraph, because it: (a) uses the phrase "means for"; (b) modifies the phrase "means for" with functional language; and (c) does not modify the phrase "means for" with structure for achieving the function. From MPEP 2181:

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

The disclosure does not identify the corresponding structure that performs the recited function of claim 1. The disclosure describes a "mast maintaining mechanism"

on page 5. Due to inconsistent language, it is not clear if this is the corresponding structure. And if the mechanism is the corresponding structure, then it is unclear if the corresponding structure is the halyard and cleat, or the halyard, cleat, and VELCRO. Since the corresponding structure is not properly identified, it is impossible for the skilled artisan to determine the corresponding structure and its equivalents. 35 USC 112 6th Paragraph states that: "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." If one cannot determine the corresponding structure and equivalents thereof, then one cannot determine the statutory scope of the claim coverage. Thus the claim is indefinite. Therefore the claim fails to satisfy 35 USC 112 2nd Paragraph. Claims 2-7 depend from claim 1 and are rejected for the same reason. Claim 8 has a similar recitation and claims 9-12 depend from claim 8. For examination it will be assumed that the corresponding structure is the: halyard, cleat, and VELCRO member.

Allowable Subject Matter

13. Claims 1-4, 6, 8-10, and 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

14. The following is an examiner's statement of reasons for allowance: regarding claims 1 and 8, the prior art does not teach or suggest the claimed combination specifically including a sailboard with the stationary and moveable mast, the backrest, the traveler, and the rudder.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maguerez et al. ('734) shows a sailboard with a seating section, mast, sail, dagger, and rudder. Ross ('607, provided by applicant) shows a sailboard with a seating section, mast, sail, dagger, and rudder. Cornell ('013) shows a sailboard with a seating section, mast, sail, dagger, and rudder.

16. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/824,790

Page 7

Art Unit: 3617

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

for 10/27/04
ANDREW D. WRIGHT
PRIMARY EXAMINER